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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re application of: Vicki D. NAISH et al.

Group Art Unit: 3627

Serial No.: 09/839,037

Examiner: J. A. Fischetti

Filed: April 19, 2001

Confirmation No.: 3621

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For: METHOD AND APPARATUS FOR CUSTOMER STOREFRONT
OPERATIONS

Docket No.: H0002193--3170

15 Customer No.: 000128

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

20

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Commissioner for Patents

P.O. Box 1450

25 Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief under 37 C.F.R. § 41.37 appealing the final rejection of the
30 Examiner dated August 24, 2004. Each of the topics required by 37 C.F.R. § 41.37 is presented
in this Brief and is labeled appropriately.

I. Real Party in Interest

Honeywell International, Inc. ("Honeywell") is the real party in interest of the present application. An assignment of all rights in the present application to Honeywell was executed by the inventor and recorded by the U.S. Patent and Trademark Office at Reel 012108, Frame
5 0246.

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which
10 Appellant is aware.

III. Status of Claims

Claims 14-23, which are presented in the Claims Appendix, stand finally rejected.
15 Accordingly, the Appellant hereby appeals the final rejection of Claims 14-23.

IV. Status of Amendments

Following a Restriction Requirement dated December 23, 2003, Appellant filed a
20 response on January 22, 2004, electing Claims 14-23, and withdrawing Claims 1-13 and 24-36
from further consideration. Thereafter, following a first Office action on the merits dated
February 26, 2004, Appellant filed an amendment on May 21, 2004. In the amendment, Claim
14 was amended to more clearly define the invention. In response to this amendment, a final
Office action, dated August 24, 2004, was issued, once again rejecting all of the pending claims.
25 In response to the final Office action, Appellant filed a response on October 20, 2004, requesting
reconsideration of the rejection of Claims 14-23. In response to this request, an Advisory Action
was issued on November 16, 2004.

V. Summary of Claimed Subject Matter

The present invention relates to a data processing system adapted to manage the transfer of parts that are stored in a secure area (130) by a supplier to a customer via a computer network (220). In one exemplary embodiment, the system includes a storefront database (140, 240), a processor (200, 2200), and a memory (200, 2240). The storefront database (140, 224) has secure area inventory information stored therein (pg. 7, ll. 19-32; pg. 10, ll. 20-21). The processor (200, 2200) is in operable communication with the storefront database (140, 240), and is configured to selectively communicate with a customer client (240) and a supplier client (230) via the computer network (220) (pg. 9, ll. 11-21; pg. 10, ll. 22-38). The memory (200, 2240) is operably coupled to the processor (200, 2200) and has program instructions stored therein, which the processor (200, 2200) is operable to execute (pg. 10, ll. 6-12). The program instructions include receiving secure area part reception information (310) from the customer client (240) via the computer network (220), and updating the secure area inventory information (312) stored on the storefront database (140, 240) using the secure area part reception information (pg. 13, ll. 12-23). The instructions further include receiving secure area part issuing information (304) from the customer client via the computer network (220), and updating the secure area inventory information (306) using the secure area part issuing information (pg. 12, l. 33 through pg. 13, l. 8).

VI. Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed in this appeal are as follows:

1. Claims 14-16, and 18 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Nos. 5,886,634 (Muhme) and 6,493,724 (Cusack et al.).
2. Claims 17, 19, 20, 22, and 23 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Muhme, Cusack et al. and U.S. Patent No. 6,487,479 (Nelson).

3. Claim 21 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Muhme, Cusack et al., Nelson, and U.S. Patent No. 6,220,509 (Byford).

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VII. ArgumentsI. CLAIMS 14-16, AND 18 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 103 OVER MUHME IN VIEW OF CUSACK ET AL.

10 In the final Office Action dated August 24, 2004, Claims 14-16, and 18 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Muhme and Cusack et al.. As will be explained in more detail herein below, this rejection is not tenable at least because elements recited in independent Claim 14 are not found in either of the cited references.

15

A. Muhme

Muhme relates to a system and method for authorizing removal of one or more items from a facility. The system includes a plurality of RFID tags (20, 22), one or more RFID readers (100, 102) included in a base station (108), an inventory database (38) in an inventory control system (36), and an interface (40) that allows entry and modification of data stored in the database (38) and to retrieve ingress and egress information therefrom. The RFID tags are associated with an item and a person. The RFID reader reads the RFID tags, and then consults the inventory database (38), via an inventory interface (124), to determine if a proper association exists between the tagged item(s) and the person. If a proper association exists, then item removal is allowed and the inventory interface (124) communicates ingress and egress information to the inventory control system (36) and the inventory database (38) with new location and status information.

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B. Cusack et al.

Cusack et al. relates to a system and method for managing and distributing an inventory of perishable samples, such as biological samples, and includes a host site (12) in communication

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with a database (14), via a search engine (13). A sample provider (16) and a sample buyer (18) can access the host site (12) via a distributed communication network, and may initiate searches of the database (14).

5 C. Analysis

It is well settled that the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Examiner has the burden of setting forth a detailed evidentiary basis for the teaching, suggestion or motivation to combine the cited references. As the Court of Appeals for the Federal Circuit recently reiterated,
10 the factual inquiry of whether to combine references must be thorough and searching, and must be based upon objective evidence of record. In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, a claim cannot be found *prima facie* obvious unless all the elements of the claim are taught or suggested in the cited art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); In re Wilson, 424 F.2d 1382, 1385 (C.C.P.A. 1970) ("All words in a claim
15 must be considered in judging the patentability of that claim against the prior art."). Just because a prior art reference *can* be modified does not render the proposed modification obvious unless the prior art suggests the desirability of making the proposed modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Appellants submit that the Examiner has not met his burden, since the references do not teach or suggest all of the claim elements.

20 Independent Claim 14 relates to a data processing system adapted to manage the transfer of parts stored in a secure area by a supplier to a customer via a computer network. The data processing system includes a storefront database having secure area inventory information stored therein, a processor in operable communication with the storefront database that is configured to selectively communicate with a customer client and a supplier client via the computer network,
25 and memory coupled to the processor. The memory has program instructions stored therein that the processor executes. Included among these program instructions are: (1) receiving secure area part reception and issuing information from the customer client via the computer network, and (2) updating the secure area inventory information in the storefront database using, as appropriate, the reception and issuing information.

In the final Office action the Examiner alleges that the interface (40) of Muhme corresponds to the claimed processor, that the wireless interface (102) corresponds to the computer network, and that the disclosed interface (40) executes the claimed program instructions. Appellant submits that these alleged correspondences are clearly erroneous since
5 nowhere does Muhme disclose, or even remotely suggest, that the interface (40) executes instructions that include either receiving secure area part reception information or secure area part issuing information from a customer client, nor that the interface (40) updates the inventory database (38) using such information. Rather, as is noted in the above summary of Muhme, it is
10 the inventory interface (124) within the base station (108) that updates the inventory database (38) with ingress and egress information. Furthermore, even assuming, *arguendo*, that in the alternative the base station (108) corresponds to the claimed processor, neither the base station (108) nor any portion thereof receives secure area part reception information from a customer client via a computer network, as is recited in independent Claim 14.

In addition to the above deficiency, Appellant submits that Muhme fails to disclose, or
15 even remotely suggest, that any portion of the disclosed system (10), including neither the interface (40) nor the base station (108), is configured to selectively communicate with a customer client and a supplier client via the computer network. Nonetheless, in the final Office action the Examiner cites Cusack et al., and alleges that its teaching makes up for this deficiency.

While not conceding the propriety of combining Muhme and Cusack et al., nor the
20 analysis proffered by the Examiner in the final Office action, Appellant submits that Cusack et al. at least fails to disclose, or even remotely suggest, the previously noted deficiency of Muhme. Namely, Appellant submits that neither of these references teaches or suggests, either alone or in combination, a processor that executes instructions that include receiving secure area part reception or issuing information from a customer client, and updating a storefront database using
25 such information, as is recited in independent Claim 14.

Finally, Appellant wishes to address the Advisory Action of November 16, 2004, in which the Examiner states, "Applicant's (sic) focus on 'a vcomputer (sic) network' is unduly narrow given the broad scope of interpretation of what a computer network may constitute." See Advisory Action at pg. 2. In response, Appellant notes that, while it does not concede to the
30 "broad scope of interpretation" alleged in the final Office action, even if such a broad reading is

adopted, nowhere do the cited references, either alone or in combination, disclose the above-noted elements of independent Claim 14. In particular, no matter how broadly one wants to interpret a computer network, nowhere is there a teaching or suggestion that any portion of the disclosed system is configured to selectively communicate with a customer client *and* a supplier client via the computer network.

In view of the foregoing, Appellant submits that independent Claim 14 is not obvious in view of Muhme and Cusack et al. Moreover, because independent Claim 14 is nonobvious, then dependent Claims 15, 16, and 18 are also nonobvious. In re Fine, supra.

II. CLAIMS 17, 19, 20, 22, AND 23 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 103 OVER MUHME, AND CUSACK ET AL. IN VIEW OF NELSON.

The final Office action of May 28, 2004, also rejected Claims 17, 19, 20, 22, and 23 under 35 U.S.C. § 103 as being unpatentable over Muhme, and Cusack et al., in view of Nelson. As will be explained in more detail herein below, this rejection is not tenable for at least the same reason delineated above.

A. Muhme and Cusack et al.

Muhme and Cusack et al. were each described above, and will therefore not be described further.

B. Nelson

Nelson relates to a system and method for accessing aircraft-related component repair orders. The system (10) includes a server (14), to which a plurality of client devices (16) are connected via the Internet. The server (14) includes various applications and databases (18-28) that allow customers and users to access and store repair-related information.

C. Analysis

As is clear from the previous description, Muhme and Cusack et al., in combination, fail to disclose at least one feature of independent Claim 14. Moreover, Appellant submits that it is readily apparent from the description of Nelson that this reference fails to disclose at least the
5 deficient features of independent Claim 14, and thereby fails to make up for the previously noted deficiencies of the Muhme and Cusack et al. combination.

Because all of the elements in independent Claim 14 are not taught or suggested in the cited art, a *prima facie* case of obviousness has not been established. As such, dependent Claims
10 17, 19, 20, 22, and 23 are also nonobvious.

III. CLAIM 21 IS NOT UNPATENTABLE UNDER 35 U.S.C. § 103 OVER
MUHME, CUSACK ET AL., NELSON IN VIEW OF BYFORD.

A. Muhme, Cusack et al., and Nelson

Muhme, Cusack et al., and Nelson were each described above, and will therefore not be described further.

B. Byford

Byford relates to a system for tracing parcels. The system includes relay software (30),
20 loaded on a server (60'), that is adapted to communicate with clients across the Internet and with a server database (20'). The server database (20') stores a plurality of parcel objects that include a parcel identifier attribute, a parcel location attribute, and a URL attribute for each client. A client database controller (70) communicates with the relay (30), via the Internet. The relay (30),
25 in response to a change in state of the parcel location attribute, supplies the change in state to the client database controller (70). In turn, the client database controller (70) writes the change of state to a client database (80). The client database controller (70) is further responsive to parcel location requests from the client to return a location and a parcel identifier for any parcels requested by the client.

C. Analysis

As is clear from the previous description, Muhme, Cusack et al., and Nelson, in combination, fail to disclose at least one feature of independent Claim 14. Moreover, Appellant submits that it is readily apparent from the description of Byford that this reference fails to disclose at least the deficient features of independent Claim 14, and thereby fails to make up for the previously noted deficiencies of the Muhme, Cusack et al., and Nelson combination.

Because all of the elements in independent Claim 14 are not taught or suggested in the cited art, a *prima facie* case of obviousness has not been established. As such, dependent Claim 21 is also nonobvious.

IV. CONCLUSION OF ARGUMENTS

In view of the foregoing, Appellant submits that the final rejection of Claims 14-23 is improper and should not be sustained. Therefore, a reversal of the rejections in the final Office Action dated August 24, 2004 is respectfully requested.

Dated

3/25/05

Respectfully submitted,


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VIII. CLAIMS APPENDIX

Claims on Appeal

14. A data processing system adapted to manage transfer of parts stored in a secure
5 area by a supplier to a customer via a computer network, comprising:

a storefront database having secure area inventory information stored therein;

a processor in operable communication with the storefront database, and configured to
selectively communicate with a customer client and a supplier client via the computer network;
and

10 a memory operably coupled to the processor and having program instructions stored
therein, the processor being operable to execute the program instructions, the program
instructions including:

receiving secure area part reception information from the customer client via a the
computer network;

15 updating the secure area inventory information stored on the storefront database
using the secure area part reception information;

receiving secure area part issuing information from the customer client via the
computer network; and

20 updating the secure area inventory information using the secure area part issuing
information.

15. The data processing system of claim 14, wherein the secure area is located at a
site controlled by the customer.

25 16. The data processing system of claim 14, wherein the secure area is located at a
neutral site.

17. The data processing system of claim 14, the program instructions further
including:

generating by the data processing system a new part invoice when a new part is being issued according to the secure area part issuing information; and

generating by the data processing system a fixed price invoice for rebuilding a rotatable part core when a rotatable part is being issued according to the secure area part issuing
5 information.

18. The data processing system of claim 14, wherein the storefront database is a neutral database.

10 19. The data processing system of claim 14, the program instructions further including:

receiving by the data processing system from the customer client via the computer network customer identification information;

accessing a customer profile database including customer document customization
15 information associated with customer identification information;

retrieving by the data processing system from the customer profile database customization information using the customer identification information; and

generating by the data processing system customized documents using the customization
information.

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20. The data processing system of claim 14, the program instructions further including:

receiving by the data processing system from the customer client via the communications network core return information including a quantity of cores returned;

25 incrementing a core credit by the quantity of cores returned;

receiving by the data processing system from the customer client via the communications network rotatable part issue information including a quantity of rotatable parts to issue; and

updating the secure area information if the quantity of rotatable parts to issue is not greater than the core credit quantity.

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21. The data processing system of Claim 14, the program instructions further including:

storing in-transit shipment information in the storefront database, the in-transit shipment information including a waybill number from a carrier for accessing shipment status information from a carrier Web server; and

receiving by the data processing system from a client via the computer network an in-transit shipment query; and

generating by the data processing system an in-transit document including a hypertext link to the carrier Web server, the hypertext link comprising the waybill number.

22. The data processing system of claim 14, the program instructions further including:

maintaining by the data processing system in the storefront database a history of part transactions for a secure area;

receiving by the data processing system a part transaction history request from a client via the computer network, the part transaction history request including a part number; and

generating by the data processing system a part history report document using the history of part transactions and the part number.

23. The data processing system of claim 22, the part history report document further including a link to an alternatively formatted part history report document.

IX. EVIDENCE APPENDIX

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 has been entered by the Examiner or relied upon by Appellant in the instant appeal.

X. RELATED PROCEEDINGS APPENDIX

As there are no related appeals and interferences, there are also no decisions rendered by a court or the Board of Patent Appeals and Interferences that are related to the instant appeal.

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